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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,129	12/12/2001	Yeong-Taeg Kim	SAM2.0004	.2469
23386 7590 01/02/2008 MYERS DAWES ANDRAS & SHERMAN, LLP 19900 MACARTHUR BLVD., SUITE 1150 IRVINE, CA 92612			EXAMINER KONIG, ANDREW Y	
			ART UNIT 2623	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/021,129

Applicant(s)

KIM, YEONG-TAEG

Examiner

Andrew Y. Koenig

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 4 and 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (U.S. 6,698,020) in view of Neel (U.S. 5,838,314).

Considering claim 1, Zigmond discloses a method for operating a digital television receiver, which comprises:

providing a digital television receiver (fig. 3, el. 60; col. 7, lines 37-67) performing a Digital TV function (selecting and displaying advertisements—col. 7, lines 25-49) including receiving and outputting information (receiving a programming feed 52 and outputting it for display—col. 7, lines 25-49);

storing a plurality of advertisement messages in a storage device (fig. 5, elements 83 and 86; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

subsequent to storing the plurality of the advertisement messages, using the digital television receiver to receive video data from a digital television service provider for subsequent output with the advertisement using the Digital TV function of the digital television receiver (fig. 3, el. 66; col. 8, lines 29-38; col. 7, lines 1-25);

accessing the stored advertisement messages in the storage device (col. 15, lines 17-34);

with the digital television receiver, arranging (pre-screen and/or pre-filter—col. 15, lines 17-34) and outputting the plurality of the advertisement messages and the received video data (fig. 3, el. 58; col. 8, lines 29-38);

maintaining a count of the number of the plurality of the advertisement messages that has been output by the digital television receiver (col. 13, lines 40-47); and

Zigmond teaches a predetermined number of the plurality of the advertisement messages have been output by the digital television receiver (eg. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47), then disabling the digital TV function (in this case, disable the display of the advertisement to the viewer—col. 13, lines 40-47) of the digital television receiver, but is silent on determining whether the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver.

In analogous art, Neel teaches determining whether the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver in that Neel discloses providing content for free or at a reduced rate providing

the user can respond to an interactive advertisement (see figure 5, col. 19, ll. 22-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zigmond by determining whether the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver as taught by Neel in order to gather more sales, marketing, and user data, while having an advertiser pay for video services (col. 6, ll. 18-33).

As to claim 2, Zigmond discloses that after the digital TV function has been disabled, such that video data from the digital television service provider are no longer output, storing a new set of the plurality of advertisement messages in the storage device (advertisements continue to be transmitted col. 8, lines 29-39, and new advertisements are stored after an advertisement has reached its desired number viewing times col. 13, lines 40-47); and subsequently enabling the digital TV function of the digital television receiver (ads that have not reached the desired number viewing counts proceed to be displayed col. 8, lines 29-39).

With regards to claim 3, Zigmond discloses performing the step of storing the new set of the plurality of the advertisement messages in the storage device by downloading the new set of the plurality of the advertisement messages from a network (fig. 8, el. 64; col. 8, lines 29-37).

Regarding claim 4, Zigmond discloses setting the predetermined number such that all of the plurality of the advertisement messages that were stored will be output (advertisers pay for a guaranteed number of exposures col. 14, lines 49-58).

Considering claim 6, Zigmond discloses providing the storage device as a component of the digital television receiver (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

As to claim 7, Zigmond discloses performing the step of storing the plurality of the advertisement messages by downloading the plurality of the advertisement messages from a network (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

With regards to claim 8, Zigmond discloses receiving additional video data from the digital television service provider; with the digital television receiver, outputting the additional video data without outputting the plurality of the advertisement messages (col. 18, line 38 to col. 19, line 9); and limiting a duration that the step of outputting the additional video without outputting the plurality of the advertisement messages can be performed (information relating to program description that appear in the feed. Since programs change, topics change and appear for a duration; col. 18, line 38 to col. 19, line 9).

4. Claims 5, 12, 13, and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (U.S. 6,698,020) and Neel (U.S. 5,838,314) in view of Knudson (U.S. 7,039,935).

Regarding claim 5, Zigmond teaches outputting the plurality of advertisement messages that were stored to be output (col. 15, lines 17-34; col. 18, lines 29-63). Zigmond fails to specifically teach a banner and performing the outputting step such that the plurality of advertisement messages that were stored are output as banner as advertisement messages together with the received video data.

Knudson teaches the use of advertising banners in conjunction with video (fig. 6, 7, 8, 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the advertisements of Zigmond and Neel with the banners as taught by Knudson in order to effectively convey both advertising information and video content to the user.

As to claim 12, Zigmond discloses a digital television receiver, comprising:
a receiving module (home entertainment system/household 56 in figure 3—column 6, lines 30-47) for receiving video bit streams (video programming feed 52 in figure 3) from a service provider (50 in figure 3 and column 7, lines 1-34);
a program selector for selecting a program (inherently disclosed in column 7, lines 26-49);

a video decoder for decoding received video bit streams of a selected program to obtain decoded video bit streams of the selected program (col. 6, lines 40-47);

an banner storage device (fig. 5, el. 86) for storing data representing advertisement messages and thereby obtaining stored data (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

an banner rendering unit for decoding and rendering selected ones of the stored data to obtain rendered data (fig. 5, el. 84, 86, 83; [15, 16-34]; [12, 33-43]);

a counter module that is configured to maintain the number of advertisement messages read out from said banner storage device (el. 61 of figure 4 counts the number of times a viewer has seen a selected ad—col. 13, lines 40-47);

an ad manager unit for reading out the stored data from said banner storage device and for providing the stored data to said banner rendering unit, said banner manager unit checking the counter module and generating a disable signal when a predetermined number of the advertisement messages, represented by the stored data, have been read out from the banner storage device (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47); and

Zigmond teaches a predetermined number of the plurality of the advertisement messages have been output by the digital television receiver (eg. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-

47), then disabling the digital TV function (in this case, disable the display of the advertisement to the viewer—col. 13, lines 40-47) of the digital television receiver, but is silent on determining whether the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver.

In analogous art, Neel teaches determining whether the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver in that Neel discloses providing content for free or at a reduced rate providing the user can respond to an interactive advertisement (see figure 5, col. 19, ll. 22-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zigmond by determining whether the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver as taught by Neel in order to gather more sales, marketing, and user data, while having an advertiser pay for video services (col. 6, ll. 18-33).

Zigmond and Neel are silent on banners. Knudson teaches the use of advertising banners in conjunction with video (fig. 6, 7, 8, 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the advertisements of Zigmond and Neel with the banners as taught by Knudson in order to effectively convey both advertising information and video content to the user.

As to claim 13, Zigmond discloses a system control unit for receiving the disable signal and, in response thereto, for prohibiting said output terminal from receiving the information representing the selected program (el. 61 counts the number of times a

viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47).

As to claim 15, a network adapter (inherently inside the STB) for downloading the stored data into said banner storage device from an external network (fig. 7, el. 64; col. 8, lines 29-37; fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

5. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (U.S. 6,698,020) and Neel (U.S. 5,838,314) in view of Gupta (US 2004/0073947) and Dimitrova (US 6,469,749)

As to claims 9 and 10, Zigmond fails to specifically teach initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed; decrementing the counter by an amount corresponding to an amount of time that the step of outputting the additional video without outputting the plurality of the advertisement messages is being performed; and when the counter reaches the predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages.

In an analogous art, Gupta discloses:

initializing a counter to a predetermined value (counter resets to zero [0074]);

incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed ([0074]; [0078]; [0085]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond's system to teach performing the limiting step by: initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed, as taught by Gupta, so as to allow monitoring of media and determine which information to output.

Zigmond fails to specifically disclose: decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing the step of outputting the advertisement messages.

In an analogous art, Dimitrova discloses a system of decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages (the commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond in view of Gupta system to teach decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages, as taught by Dimitrova, so as to allow the system to determine how long to allow the commercial to air.

As to claim 11, Gupta discloses providing the counter as a component of the digital television receiver (fig. 2, el. 180; [0074]).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over over Zigmond (U.S. 6,698,020), Neel (U.S. 5,838,314), and Knudson (U.S. 7,039,935) in view of Gupta (US 2004/0073947) and Dimitrova (US 6,469,749)

As to claim 14, Zigmond discloses that said video reconstruction unit is outputting the information representing the selected program without the rendered data (col. 18, line 38 to col. 19, line 9).

Zigmond fails to teach a counter having a value that is incremented.

In an analogous art, Gupta discloses a system of a counter having a value that is incremented ([0074]; [0078]; [0085]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system Zigmond and Kim to a counter having a value

that is incremented, as taught by Gupta, so as to allow monitoring of media and determine which information to output.

Zigmond fails to specifically disclose that said value of said counter being decremented in proportion to an amount of time during and when the value of said counter reaches a predetermined lower limit value, said video reconstruction unit being prohibited from outputting the information.

In an analogous art, Dimitrova discloses a system said value of said counter being decremented in proportion to an amount of time during and when the value of said counter reaches a predetermined lower limit value, said video reconstruction unit being prohibited from outputting the information (the commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond in view of Gupta system to teach decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages, as taught by Dimitrova, so as to allow the system to determine how long to allow the commercial to air.

Conclusion

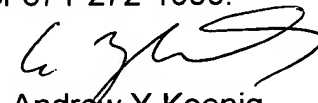
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Y Koenig
Primary Examiner
Art Unit 2623

ayk